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23363	7590	02/08/2005	HUTTON JR, WILLIAM D

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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/801,949	ANECKI ET AL.
	Examiner	**Art Unit**	
	Doug Hutton	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 October 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-52</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-52</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>11 June 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

Applicant's Response

In Applicant's Responses dated 26 October 2004 and 28 October 2004,

Applicant added new Claim 52, and argued against all objections and rejections

previously set forth in the Office Action dated 28 July 2004.

The objection to the Specification is withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 8, 9, 18, 23, 25, 26, 35, 40, 42 and 43 remain rejected under 35

U.S.C. 102(b) as being anticipated by Shirley et al., U.S. Patent No. 5,692,206.

Claim 1:

Shirley discloses a method for interactively generating and delivering documents

requested by a requestor for a recipient via a computer network (see Figures 1-12; see

Column 1, Line 64 through Column 2, Line 61 – the document generation method

discloses this limitation in that a user interactively creates a legal document and

transmits the document to another computer user via E-mail), comprising:

- receiving from the requestor via the computer network a document request, the

    document request including recipient and subject matter information (see Figures

6 and 7; see Column 6, Line 64 through Column 9, Line 30; specifically, see Column 7, Lines 22-34 – The document generation method discloses this limitation in that the user selects the type of contract to be generated and enters the names and addresses of the parties to the contract, the term of the contract and relevant financial information. As explained in the "Response to Arguments" section of this Office Action, the computer at which the user makes the document request is part of a "computer network.");

- generating a document according to the recipient and subject matter information (see Figures 6 and 7; see Column 6, Line 64 through Column 9, Line 30; specifically, see Column 7, Lines 22-34 – the document generation method discloses this limitation in that the contract generation system incorporates the data entered by the user into the contract);

- storing the document in a document database (see Figures 6 and 7; Column 6, Line 64 through Column 9, Line 30; specifically, see Column 9, Lines 27-30 – the document generation method discloses this limitation in that the user saves the contract in a contract folder); and

- transmitting the document to the recipient (see Figures 6 and 7; see Column 12, Lines 3-18 – the document generation method discloses this limitation in that the user transmits the contract to another computer user via E-mail).

Claim 6:

Shirley discloses the method of Claim 1, wherein transmitting the document to

the recipient comprises transmittal by electronic mail (as indicated in the above

discussion, the document generation system discloses transmitting the contract via E-

mail), the electronic mail further including document execution instructions (see Figures

6 and 7; see Column 2, Lines 14-18; see Column 10, Line 44 through Column 11, Line

17 – the document generation method discloses this limitation in that the user can add

auxiliary documents to the contract, said auxiliary documents regarding action items

pertinent to the execution of the contract).

Claim 8:

Shirley discloses the method of Claim 1, further comprising:

- receiving via the computer network a document amendment request from a

  requestor, the document amendment request including a document identifier and

  subject matter information (see Figures 6 and 7; see Column 6, Line 64 through

  Column 9, Line 30 – the document generation method discloses this limitation in

  that the user selects the type of contract to be generated and the system loads

  the appropriate "basic provisions document" into the contract folder; at the same

  time the contract is identified, the user enters the names and addresses of the

  parties to the contract, the term of the contract and relevant financial information,

  and the system incorporates this information into the contract; thus, the system

  receives a "document identifier" and "subject matter information" from the user,

retrieves an existing contract and incorporates the "amendments" into the

contract);

- retrieving a stored document from the document database using the document

    identifier (as indicated in the above discussion, the document generation method

    discloses this limitation);

- generating a document amendment using the subject matter information and the

    retrieved document (as indicated in the above discussion, the document

    generation method discloses this limitation);

- storing the document amendment in the document database (see Figures 6 and

    7; Column 6, Line 64 through Column 9, Line 30; specifically, see Column 9,

    Lines 27-30 – the document generation method discloses this limitation in that

    the user saves the amended contract in a contract folder); and

- transmitting via the computer network the document amendment to the recipient

    (see Figures 6 and 7; see Column 12, Lines 3-18 – the document generation

    method discloses this limitation in that the user transmits the amended contract

    to another computer user via E-mail).

Claim 9:

Shirley discloses the method of Claim 8, wherein the document is a version

controlled document (see Column 7, Line 50 through Column 8, Line 9 – the document

generation method discloses this limitation in that it retains multiple versions of the

contract).

Claim 18:

Shirley discloses a data processing system adapted to interactively generate and

deliver documents requested by a requestor for a recipient via a computer network (see

Figure 1C; see Column 3, Lines 39-55 – the document generation system performs

these functions, as indicated in the above rejection for Claim 1), comprising:

- a processor (see Figure 1C; see Column 3, Lines 39-55 – the document

    generation system discloses a CPU); and

- a memory operably coupled to the processor and having program instructions

    stored therein, the processor being operable execute the program instructions

    (see Figure 1C; see Column 3, Lines 39-55 – the document generation system

    discloses a memory), the program instructions including:

- receiving from the requestor via the computer network a document request, the

    document request including recipient and subject matter information (as indicated

    in the above rejection for Claim 1, Shirley discloses these limitations);

- generating a document according to the recipient and subject matter information

    (as indicated in the above rejection for Claim 1, Shirley discloses this limitation);

- storing the document in a document database (as indicated in the above

    rejection for Claim 1, Shirley discloses this limitation); and

- transmitting the document to the recipient (as indicated in the above rejection for

    Claim 1, Shirley discloses this limitation).

Claims 23, 25 and 26:

As indicated in the above rejections for Claims 6, 8 and 9, Shirley discloses the

limitations of Claims 23, 25 and 26, respectively.

Claims 35, 40, 42 and 43:

These claims merely recite computer software for performing the methods of

Claims 1, 6, 8 and 9, respectively. Thus, Shirley discloses the limitations of Claims 35,

40, 42 and 43, as indicated in the above rejections for Claims 1, 6, 8 and 9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 5, 22 and 39 remain rejected under 35 U.S.C. 103(a) as being

unpatentable over Shirley.

Claim 5:

As indicated in the above rejection, Shirley discloses every limitation of Claim 1.

Also, as indicated in the above rejection for Claim 6, Shirley discloses transmitting the

generated contract by E-mail, said E-mail including auxiliary documents regarding

action items pertinent to the execution of the contract.

Shirley fails to expressly disclose transmitting the document to the recipient by facsimile transmission, the facsimile transmission further including document execution instructions. However, the examiner takes Official Notice that it was well-known by one of ordinary skill in the art at the time the invention was made that a document, and any supporting documents, can be transmitted via a facsimile transmission for the purpose of quickly delivering a document to a desired recipient.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Shirley, to include transmitting the document to the recipient by facsimile transmission, the facsimile transmission further including document execution instructions for the purpose of quickly delivering a document to a desired recipient.

Claim 22:

As indicated in the above rejection for Claim 5, Shirley teaches the limitations of Claim 22.

Claim 39:

This claim merely recites computer software for performing the method of Claim 5. Thus, Shirley teaches the limitations of Claim 39, using the same rationale used in the above rejection for Claim 5.

Claims 7, 24 and 41 remain rejected under 35 U.S.C. 103(a) as being

unpatentable over Shirley, in view of Owens et al., U.S. Patent No. 6,236,984.

Claim 7:

As indicated in the above rejection, Shirley discloses every limitation of Claim 1.

Shirley fails to expressly disclose:

- receiving a document status request via the computer network from the

  requestor, the document status request including a recipient identification;

- generating a document status report using the document database and the

  recipient identification; and

- transmitting via the computer network the document status report to the

  requestor.

Owens teaches a method for interactively generating and delivering documents

via a computer network (see Figures 1-4; see Column 5, Line 57 through Column 6,

Line 4; see Column 6, Lines 29-37 – the document generation system discloses this

limitation in that), comprising:

- receiving a document status request via the computer network from the

  requestor, the document status request including a recipient identification (see

  Figure 4B; see Column 3, Line 66 through Column 4, Line 11; see Column 8,

  Lines 21-56 – the document processing system discloses this limitation in that it

  allows the user to request a search of the contract database to find contracts

  involving a particular contracting party);

- generating a document status report using the document database and the

  recipient identification (see Figure 4C; see Column 8, Lines 21-56 – the

  document processing system discloses this limitation in that it performs a search

  of the database using the search terms provided by the user); and

- transmitting via the computer network the document status report to the

  requestor (see Figure 4C; see Column 8, Lines 21-56 – the document processing

  system discloses this limitation in that it produces a list of the results of the

  search),

for the purpose of searching a contract database to find contracts involving a particular

contracting party (see Figure 4B; see Column 3, Line 66 through Column 4, Line 11;

see Column 8, Lines 21-56).

Accordingly, it would have been obvious to one having ordinary skill in the art at

the time the invention was made to modify the method, disclosed in Shirley, to include:

- receiving a document status request via the computer network from the

  requestor, the document status request including a recipient identification;

- generating a document status report using the document database and the

  recipient identification; and

- transmitting via the computer network the document status report to the

  requestor,

for the purpose of searching a contract database to find contracts involving a particular

contracting party, as taught by Owens.

Claim 24:

As indicated in the above rejection for Claim 7, Shirley, in view of Owens

discloses/teaches the limitations of Claim 24.

Claim 41:

This claim merely recites computer software for performing the method of Claim

7. Thus, Shirley, in view of Owens, discloses/teaches the limitations of Claim 41, as

indicated in the above rejection for Claim 7.

Claims 2, 4, 19, 21, 36 and 38 remain rejected under 35 U.S.C. 103(a) as being

unpatentable over Shirley, in view of Rutten et al., U.S. Patent No. 6,632,251.

Claim 2:

As indicated in the above rejection, Shirley discloses every limitation of Claim 1.

Shirley fails to expressly disclose obtaining approval from a document

administrator before generating the document.

Rutten teaches a method for interactively generating and delivering documents

via a computer network (see Figures 1-4; see Column 5, Line 57 through Column 6,

Line 4; see Column 6, Lines 29-37 – the document generation system discloses this

limitation in that it allows project members to produce and E-mail documents and on a

computer system), comprising:

- obtaining approval from a document administrator before generating a document (see Column 6, Lines 64-67 – the document generation system discloses this limitation in that it requires approval from a manager before the document is published),

for the purpose of ensuring that the document is worded properly (see Column 6, Lines 52-67).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Shirley, to include obtaining approval from a document administrator before generating a document for the purpose of ensuring that the document is worded properly, as taught by Rutten.

Claim 4:

As indicated in the above rejection, Shirley discloses every limitation of Claim 1. Shirley also discloses:

- receiving via the computer network document transmission instructions from the requestor (see Figures 6 and 7; see Column 12, Lines 3-18 – the document generation method discloses this limitation in that the system receives an E-mail address from the user and transmits the contract to the specified address).

Shirley fails to expressly disclose:

- transmitting via the computer network a document generation notice to the requestor.

Rutten teaches a method for interactively generating and delivering documents via a computer network (see Figures 1-4; see Column 5, Line 57 through Column 6, Line 4; see Column 6, Lines 29-37 – the document generation system discloses this limitation in that it allows project members to produce and E-mail documents and on a computer system), comprising:

- transmitting via the computer network a document generation notice to the requestor (see Column 3, Line 45 through Column 4, Lines 14; Column 6, Lines 53-67; see Column 7, Lines 1-17 – the document generation system discloses this limitation in that it allows the user to check the status of a document, and, because publication of a document requires approval from a manager, the user will receive a "document generation notice" before the document is published),

for the purpose of notifying the user that the document is approved for publication.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Shirley, to include transmitting via the computer network a document generation notice to the requestor for the purpose of notifying the user that the document is approved for publication, as taught by Rutten.

Claims 19 and 21:

As indicated in the above rejections for Claims 2 and 4, Shirley, in view of Rutten, discloses/teaches the limitations of Claims 19 and 21, respectively.

Claims 36 and 38:

These claims merely recite computer software for performing the methods of

Claims 2 and 4, respectively. Thus, Shirley, in view of Rutten, discloses/teaches the

limitations of Claims 36 and 38, as indicated in the above rejections for Claims 2 and 4.

Claims 3, 10-17, 20, 28-34, 37 and 44-51 remain rejected under 35

U.S.C. 103(a) as being unpatentable over Shirley, in view of Rutten, and further in view

of Kuo, U.S. Patent Application Publication No. US 2003/0120615.

Claim 3:

As indicated in the above rejection, Shirley, in view of Rutten, discloses every

limitation of Claim 2.

Shirley, in view of Rutten, fails to expressly disclose:

- creating an approval status document, the approval status document including

  the status of the approval received for generation of a document from a

  document administrator, the approval status document retrievable via the

  computer network by the requestor using an approval status document address;

  and

- transmitting via the computer network the approval status document address to

  the requestor.

Kuo teaches a method for interactively generating and delivering documents via a computer network (see Figure 1; see Paragraphs 0001-0080 – the online transaction system discloses this limitation in that it involves communication via Internet websites; thus, in conducting said communication, documents are generated and delivered via a computer network), comprising:

- creating an approval status document (see Figure 1; see Paragraphs 0054-0072 – the online transaction system discloses this limitation in that the Host stores the status of financial transactions of online orders placed by users), the approval status document including the status of the approval received for generation of a document from a document administrator (see Figure 1; see Paragraphs 0054-0072 – The online transaction system discloses this limitation in that it allows the user to query the status of online orders they have placed on the system. The "status" of online orders depends upon whether the user's payment card issuer has approved the transaction. As explained in the "Response to Arguments" section of this Office Action, the approval status document includes the status of the approval received "for generation of a document."), the approval status document retrievable via the computer network by the requestor using an approval status document address (see Figure 1; see Paragraphs 0054-0072 – the online transaction system discloses this limitation in that it allows the user to query the status of online orders via a website); and

- transmitting via the computer network the approval status document address to the requestor (see Figure 1; see Paragraphs 0054-0072 – the online transaction

system discloses this limitation in that it sends the web page, which includes the

status of the user's online order, to the user via the Internet),

for the purpose of communicating the status of approval to an interested party (see

Paragraph 0072).

Accordingly, it would have been obvious to one having ordinary skill in the art at

the time the invention was made to modify the method, disclosed in Shirley, in view of

Rutten, to include:

- creating an approval status document, the approval status document including

  the status of the approval received for generation of a document from a

  document administrator, the approval status document retrievable via the

  computer network by the requestor using an approval status document address;

  and

- transmitting via the computer network the approval status document address to

  the requestor,

for the purpose of communicating the status of approval to an interested party, as

taught by Kuo.

Claim 10:

Shirley discloses a method for interactively generating and delivering, via a

computer network, non-disclosure agreements requested by a marketing representative

for a customer (see Figures 1-12; see Column 1, Line 64 through Column 2, Line 61 –

the document generation method discloses this limitation in that a user interactively

creates a legal document and transmits the document to another computer user via E-mail; Shirley expressly discloses generating and disclosing a contract, and a non-disclosure agreement is a contract; also, Shirley expressly discloses generating negotiated contracts, which implies that the contracts are "requested by a marketing representative;" finally, Shirley expressly discloses generating contracts with another party, which implies that the contracts are "requested" "for a customer"), comprising:

- receiving from the marketing representative a non-disclosure agreement request, the non-disclosure agreement request including customer and product information (as indicated in the above rejection for Claim 1, Shirley discloses this limitation; Shirley expressly discloses the user selecting the type of contract to be generated and entering the names and addresses of the parties to the contract, the term of the contract and relevant financial information, and entry of this information reads on "customer and product information");

- generating a non-disclosure agreement according to the non-disclosure agreement request (as indicated in the above rejection for Claim 1, Shirley discloses this limitation);

- storing the non-disclosure agreement in a non-disclosure agreement database (as indicated in the above rejection for Claim 1, Shirley discloses this limitation);

- receiving non-disclosure agreement transmission instructions from the marketing representative (as indicated in the above rejection for Claim 4, Shirley discloses this limitation); and

- transmitting the non-disclosure agreement to the customer (as indicated in the above rejection for Claim 1, Shirley discloses this limitation).

Shirley fails to expressly disclose:

- obtaining approval from a non-disclosure agreement administrator before generating the non-disclosure agreement; and

- transmitting a non-disclosure agreement generation notice to the marketing representative.

Rutten teaches a method for interactively generating and delivering documents via a computer network (as indicated in the above rejection for Claim 2, Rutten discloses this limitation), comprising:

- obtaining approval from a document administrator before generating a document (as indicated in the above rejection for Claim 2, Rutten discloses this limitation),

for the purpose of ensuring that the document is worded properly.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Shirley, to include:

- obtaining approval from a non-disclosure agreement administrator before generating the non-disclosure agreement,

for the purpose of ensuring that the document is worded properly, as taught by Rutten.

Rutten also teaches a method for interactively generating and delivering documents via a computer network, comprising:

- transmitting via the computer network a document generation notice to the

    requestor (as indicated in the above rejection for Claim 4, Rutten discloses this

    limitation),

for the purpose of notifying the user that the document is approved for publication.

    Accordingly, it would have been obvious to one having ordinary skill in the art at

the time the invention was made to modify the method, disclosed in Shirley, to include:

- transmitting a non-disclosure agreement generation notice to the marketing

    representative,

for the purpose of notifying the user that the document is approved for publication, as

taught by Rutten.

    Shirley, in view of Rutten, fails to expressly disclose:

- creating an approval status document, the approval status document including

    the status of the approval received for generation of a non-disclosure agreement

    from a non-disclosure agreement administrator, the approval status document

    retrievable by the marketing representative using an approval status document

    address; and

- sending the approval status document address to the marketing representative.

    Kuo teaches a method for interactively generating and delivering documents via

a computer network (as indicated in the above rejection for Claim 3, Kuo discloses this

limitation), comprising:

- creating an approval status document, the approval status document including the status of the approval received for generation of a document from a document administrator, the approval status document retrievable via the computer network by the requestor using an approval status document address (as indicated in the above rejection for Claim 3, Kuo discloses these limitations); and

- sending the approval status document address to the requestor (as indicated in the above rejection for Claim 3, Kuo discloses this limitation),

for the purpose of communicating the status of approval to an interested party.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Shirley, in view of Rutten, to include:

- creating an approval status document, the approval status document including the status of the approval received for generation of a non-disclosure agreement from a non-disclosure agreement administrator, the approval status document retrievable by the marketing representative using an approval status document address; and

- sending the approval status document address to the marketing representative,

for the purpose of communicating the status of approval to an interested party, as taught by Kuo.

Claims 11-14:

As indicated in the above rejections for Claims 5, 6, 9 and 8, Shirley

discloses/teaches the limitations of Claims 11-14, respectively.

Claims 15-17:

As indicated in the above rejections for Claims 5, 6 and 9, Shirley

discloses/teaches the limitations of Claims 15-17, respectively.

Claim 20:

As indicated in the above rejection for Claim 3, Shirley, in view of Rutten, and

further in view of Kuo, discloses/teaches the limitations of Claim 20.

Claim 27:

As indicated in the above rejections for Claims 10 and 18, Shirley, in view of

Rutten, and further in view of Kuo, discloses/teaches the limitations of Claim 27.

Claims 28-30:

As indicated in the above rejections for Claims 9, 5 and 6, Shirley

discloses/teaches the limitations of Claims 28-30, respectively.

Claims 31, 32 and 34:

As indicated in the above rejections for Claims 8, 9 and 6, Shirley discloses the

limitations of Claims 31, 32 and 34, respectively.

Claim 33:

As indicated in the above rejection for Claim 5, Shirley teaches the limitations of

Claim 33.

Claims 37 and 44:

These claims merely recite computer software for performing the methods of

Claims 3 and 10, respectively. Thus, Shirley, in view of Rutten, and further in view of

Kuo, discloses/teaches the limitations of Claims 37 and 44, as indicated in the above

rejections for Claims 3 and 10.

Claims 45-51:

These claims merely recite computer software for performing the methods of

Claims 13, 11, 12, 14, 17, 15 and 16, respectively. Thus, Shirley discloses/teaches the

limitations of Claims 45-51, as indicated in the above rejections for Claims 13, 11, 12,

14, 17, 15 and 16.

Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shirley,

in view of Crawford et al., U.S. Patent No. 6,502,113.

Claim 52:

Shirley discloses a method for interactively generating and delivering documents

via a computer network (see Figures 1-12; see Column 1, Line 64 through Column 2,

Line 61 – the document generation method discloses this limitation in that a user

interactively creates a legal document and transmits the document to another computer

user via E-mail), the method comprising:

- receiving from a computer via the computer network a document request, the

    document request including recipient and subject matter information (see Figures

    6 and 7; see Column 6, Line 64 through Column 9, Line 30; specifically, see

    Column 7, Lines 22-34 – The document generation method discloses this

    limitation in that the user, using a computer, selects the type of contract to be

    generated and enters the names and addresses of the parties to the contract, the

    term of the contract and relevant financial information. As explained in the

    "Response to Arguments" section of this Office Action, the computer at which the

    user makes the document request is part of a "computer network.");

- searching a database for a document template associated with the document

    request (see Figure 3; see Column 5, Lines 13-45; see Column 7, Lines 14-34 –

    the document generation method discloses this limitation in that, when the user

    selects the type of contract to be generated, the contract generation system

obtains the appropriate "basic" and "general" provisions documents and inserts

them into the contract);

- inserting the recipient and subject matter information into the document template

   and generating a final document (see Figures 6 and 7; see Column 6, Line 64

   through Column 9, Line 30; specifically, see Column 7, Lines 22-34 – the

   document generation method discloses this limitation in that the contract

   generation system incorporates the data entered by the user into the contract);

- storing the final document in a data store (see Figures 6 and 7; Column 6, Line

   64 through Column 9, Line 30; specifically, see Column 9, Lines 27-30 – the

   document generation method discloses this limitation in that the user saves the

   contract in a contract folder);

- transmitting the document to the recipient (see Figures 6 and 7; see Column 12,

   Lines 3-18 – the document generation method discloses this limitation in that the

   user transmits the contract to another computer user via E-mail); and

- transmitting to the computer over the computer network a notification indicative of

   the generated final document (see Column 7, Lines 14-34 – the document

   generation method discloses this limitation in that the system incorporates the

   data entered by the user into the contract and displays it to the user).

   Shirley fails to expressly discloses a contract generation method, comprising:

- receiving from a *remote* computer via the computer network a document

   request; and

- transmitting to the *remote* computer over the computer network a notification

     indicative of the generated final document.

     Crawford teaches a method for interactively generating and delivering documents

via a computer network (see Abstract – the negotiating management system teaches

this limitation in that the system enables a user to interactively create and deliver

contracts via the Internet), the method comprising:

- receiving from a remote computer via the computer network a document request

     (see Figure 10; see Column 4, Lines 20-33; see Column 8, Line 61 through

     Column 9, Line 46 – the negotiation management system teaches this limitation

     in that users may, via remote client computers on the Internet, create new

     contracts or access existing contracts; thus, Crawford teaches "receiving from a

     remote computer via the computer network a document request"); and

- transmitting to the remote computer over the computer network a notification

     indicative of the generated final document (see Figure 13; see Column 8, Line 61

     through Column 9, Line 46; see Column 11, Lines 50-58; see Column 14, Lines

     56-59 – the negotiation management system teaches this limitation in that, during

     negotiation of the contract, the system notifies a user that issues have been

     agreed upon; once every issue of the contract has been agreed upon, the final

     contract can be displayed and printed; thus, Crawford teaches transmitting to the

     remote computer over the computer network a "notification" that is "indicative of

     the generated final document"),

for the purpose of eliminating the need to transmit paper documents back and forth during the negotiation process (see Column 4, Lines 20-33).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, to include:

- receiving from a *remote* computer via the computer network a document request; and

- transmitting to the *remote* computer over the computer network a notification indicative of the generated final document,

for the purpose of eliminating the need to transmit paper documents back and forth during the negotiation process, as taught in Crawford.

Shirley fails to expressly discloses a contract generation method, comprising:

- tracking an approval status of the final document;

- generating an approval status report including the tracked approval status; and

- transmitting the approval status report to the remote computer via the computer network.

Crawford teaches a method for interactively generating and delivering documents via a computer network (see Abstract – the negotiating management system teaches this limitation in that the system enables a user to interactively create and deliver contracts via the Internet), the method comprising:

- tracking an approval status of the final document (see Figures 13 and 15; see Column 3, Line 40 through Column 4, Line 5; see Column 11, Line 50 through Column 12, Line 18 – the negotiating management system teaches this limitation in that the system enables a user to interactively track the negotiating activity between the contracting parties, including notes regarding the negotiations between the parties; that is, the user may track which issues of the contract are agreed upon and which are not and display notes comprising specific explanations regarding the contracting parties' positions; thus, Crawford teaches "tracking an approval status of the final document");

- generating an approval status report including the tracked approval status (see Figures 13 and 15; see Column 3, Line 40 through Column 4, Line 5; see Column 11, Line 50 through Column 12, Line 18 – the negotiating management system teaches this limitation in that the system enables a user to generate a summary page for each clause of the contract; the summary page includes the "tracked approval status" in that it allows the user to click on a clause to review the status of that clause; thus, Crawford teaches "generating an approval status report including the tracked approval status"); and

- transmitting the approval status report to the remote computer via the computer network (see Figures 13 and 15; see Column 3, Line 40 through Column 4, Line 5; see Column 11, Line 50 through Column 12, Line 18 – the negotiating management system teaches this limitation, as clearly indicated in the cited figures and text),

for the purposes of generating a complete, on-going and accurate historical written record of an entire negotiation and enabling the negotiating parties to determine the status of every clause in an agreement at any time (see Column 1, Lines 57-65).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, to include:

- tracking an approval status of the final document;

- generating an approval status report including the tracked approval status; and

- transmitting the approval status report to the remote computer via the computer network,

for the purposes of generating a complete, on-going and accurate historical written record of an entire negotiation and enabling the negotiating parties to determine the status of every clause in an agreement at any time, as taught in Crawford.

Shirley discloses a contract generation method, comprising:

- receiving from the computer over the computer network a user identified transmission mode (see Column 12, Lines 3-19 – the document generation method discloses this limitation in that the system allows the user to send the contract to another via email);

- formatting the final document based on the user identified transmission mode (see Column 12, Lines 3-19 – the document generation method discloses this limitation in that the system formats the contract for transmission via email); and

- transmitting the final document to the computer over the computer network according to the user identified transmission mode (see Column 12, Lines 3-19 – the document generation method discloses this limitation in that the system transmits the contract via email), the final document being transmitted responsive to an indication of an approval of the final document (the document generation method discloses this limitation in that the user transmits the contract via email only after he has edited the contract into its final form; thus, the contract is "approved" by the user and then transmitted to the recipient via email).

Shirley fails to expressly disclose a contract generation method, comprising:

- receiving from the *remote* computer over the computer network a user identified transmission mode;

- transmitting the final document to the *remote* computer over the computer network according to the user identified transmission mode.

Crawford teaches a method for interactively generating and delivering documents via a computer network (see Abstract – the negotiating management system teaches this limitation in that the system enables a user to interactively create and deliver contracts via the Internet), the method comprising:

- receiving from the remote computer over the computer network a user identified transmission mode (see Column 4, Lines 20-33 – the negotiating management system teaches this limitation in that the system a user may access documents regarding the negotiation process via the Internet; the Internet includes HTTP, thus, the user "identifies" the HTTP "transmission mode" when requesting a document);

- formatting the final document based on the user identified transmission mode (see Column 4, Lines 20-33 – the negotiating management system teaches this limitation in that the system formats the final agreement in HTTP); and

- transmitting the final document to the remote computer over the computer network according to the user identified transmission mode (see Column 4, Lines 20-33 – the negotiating management system teaches this limitation in that the system transmits the final agreement in HTTP), the final document being transmitted responsive to an indication of an approval of the final document (see Column 3, Line 40 through Column 4, Line 5; see Column 4, Lines 20-33 – the negotiating management system teaches this limitation in that the system allows the user to transmit the final agreement after all contracting parties have agreed to all issues).

for the purpose of eliminating the need to transmit paper documents back and forth during the negotiation process (see Column 4, Lines 20-33).

Accordingly, it would have been obvious to one having ordinary skill in the art at
the time the invention was made to modify the method, disclosed in Henderson, to
include:

- receiving from the **remote** computer over the computer network a user identified
  transmission mode;

- transmitting the final document to the **remote** computer over the computer
  network according to the user identified transmission mode,

for the purpose of eliminating the need to transmit paper documents back and forth
during the negotiation process, as taught in Crawford.

Response to Arguments

Applicant's arguments filed 26 October 2004 have been fully considered but they
are not persuasive.

Arguments for Claims 1, 18 and 35:

Applicant argues that Shirley fails to disclose "receiving from the requestor *via*
the computer network a document request, the document request including recipient
and subject matter information" because the contract generation system disclosed in
Shirley is just a personal computer equipped with a program that directly receives from
a user, input of data used for generating a contract. In support of the argument,
Applicant states that "[t]he data is input by the user using 'input devices, such as the

keyboard or the pointing device.'" Applicant further states that, "[a]lthough Shirley's

contract generation system may communicate with other computers via an e-mail unit

providing conventional electronic mail functions, and as such, may arguably be deemed

to be part of a 'computer network,' nothing in Shirley teaches or suggests that the e-mail

unit is used to receive the information needed for generating the contract." See

Applicant's Response dated 26 October 2004 – Page 18, fourth paragraph through

Page 19, first partial paragraph.

The examiner disagrees.

The relevant claim language reads:

A method for interactively generating and delivering documents requested by a

requestor for a recipient *via a computer network*, comprising:

- receiving from the requestor *via the computer network* a document request

  (see Claim 1, Lines 1-5).

Shirley discloses this limitation in two ways:

Firstly, Shirley discloses a user generating a document using a "contract

generation system" (see Column 6, Lines 64-66) by selecting the "type of contract" (see

Column 7, Lines 14-15). By "selecting the type of contract," the user makes a

"document request." Subsequently, the user may transmit the document to another

computer user via E-mail (see Column 12, Lines 3-18). Because the user can "make a

document request" and "transmit the document via E-mail," the user is performing these

both of these operations **on** a "computer network." Stated another way, the computer

at which the user is located is **part of** a "computer network" in that it allows the user to

transmit E-mails. This same computer also allows the user to make a "document

request." Thus, Shirley discloses "receiving a document request" via a "computer

network."

Secondly, Shirley expressly discloses a "contract generation system" comprising

a number of functional units (see Column 4, Lines 15-17), including a "system

controller," an "authoring help unit," an "auxiliary document unit," one or more "provision

libraries," a "legal advisor," and a "contract authoring unit" (see Column 4, Lines 27-34).

Shirley also discloses that the functional units of the system may be coupled together in

any of various conventional methods (see Column 4, Lines 17-23). Conventional

methods, existing at the time the invention was made, included linking a user's

computer to databases that store the various "units" of the "system." In fact, Shirley

expressly discloses that a "database" containing "general contract data" is linked to the

contract documents containing the textual provisions of the contract (see Abstract, Lines

5-8). Moreover, Shirley also discloses that the "contract generation system" comprises

a "data entry unit" and a "print unit" (see Column 4, Lines 34-37). Thus, the "contract

generation system" itself is a "computer network" in that it comprises numerous

computer "units" that are linked together.

Accordingly, Shirley discloses "receiving from the requestor via the computer network a document request," as recited in Claim 1, Lines 4-5.

Arguments for Claims 3, 20, 37 and 44:

Applicant argues that Kuo fails to teach "creating an approval status document, *the approval status document including the status of the approval received for generation of a document from a document administrator*" because the online transaction system disclosed in Kuo is not used for "the approval received *for generation of a document* from a document administrator." See *Applicant's Response* dated 26 October 2004 – Page 20, first full paragraph.

The examiner disagrees.

The relevant claim language reads:

A method for interactively generating and delivering documents requested by a requestor for a recipient via a computer network, comprising:

- creating an approval status document, the approval status document including the status of the approval received for generation of a document from a document administrator (see Claim 1, Lines 1-3 and Claim 3, Lines 1-5).

Kuo discloses this limitation in two ways:

Firstly, the preamble of Claim 1 reads very broadly and covers the subject matter of Kuo. In fact, whenever a web user enters a URL into the address field of a browser and the web page corresponding to the entered URL appears onscreen, a "requestor" (the web user) "requests for a recipient" (the web user makes the request for himself; thus, the web user is the "requestor" and the "recipient") a "document," and said document (the web page) is "interactively generated and delivered" (through the client, the webserver and the Internet) "via a computer network" (the Internet). Kuo teaches an electronic commerce website, where a user interactively selects and purchases online goods. Thus, Kuo teaches the preamble of Claim 1.

Kuo teaches "creating an approval status document" in that the Host either approves or rejects the customer's purchase order (see Paragraphs 0064 and 0067), and Applicant does not dispute this. Kuo also teaches the approval status document "including the status of the approval received . . . from a document administrator" in that the "approval status document" comes from the Host (see Paragraphs 0064 and 0067), includes the "status of approval" (see Paragraphs 0064 and 0067). Finally, Kuo teaches that the "approval status document" includes the status of the approval received "for generation of a document" in that the customer's purchase order is fulfilled only after approval from the Host (see Paragraphs 0056, 0058, 0061, 0062, 0065-0070). Thus, after approval from the Host, the customer's purchase order is "generated" in that it is processed and fulfilled.

Secondly, the relevant language of the claim recites that the approval status

document includes the status of the approval received for "*generation of a document*"

(see Claim 3, Line 4). Thus, the claim recites that approval is sought for the generation

of *any* document and not for a *particular* document. Kuo teaches that, upon approval

of the customer's purchase order, many documents are generated (see Paragraphs

0067-0070), and these documents are generated only upon the Host's approval of the

customer's purchase order.

Accordingly, Shirley discloses "creating an approval status document, the

approval status document including the status of the approval received for generation of

a document from a document administrator," as recited in Claim 3, Lines 2-5.

Applicant argues that a person of skill in the art would have no reason to

combine the teachings of Kuo to the teachings of Shirley in view of Rutten because Kuo

is nonanalogous art. In support of the argument, Applicant states that a person of skill

in the art faced with the problem of generating and delivering documents over the

network would not turn to art relating to secure online transactions to solve the problem.

See *Applicant's Response* dated 26 October 2004 – Page 20, second full paragraph

through Page 21, first partial paragraph.

The examiner disagrees.

It has been held that a prior art reference must either be in the field of Applicant's

endeavor or, if not, then be reasonably pertinent to the particular problem with which the

applicant was concerned, in order to be relied upon as a basis for rejection of the

claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir.

1992). In this case, Kuo satisfies both requirements.

Applicant's field of invention comprises a method for generating and delivering

documents via a computer network (see Claim 1, Lines 1-3). As indicated in the above

discussion, the disclosure of Kuo teaches a method for generating and delivering

documents via a computer network. Thus, Kuo is "in the field of Applicant's endeavor."

The Applicant's "particular problem" comprises writing software code to obtain

approval before generating a document via a computer network. In designing computer

programs, regardless of what the computer program ultimately does, many of the exact

same software tools used in one program are usable other programs. For example, an

"approval/rejection" software tool for obtaining approval from an administrator could

have been used in **any** computer program that requires approval from an administrator

before completion, regardless of the ultimate function of the program (e.g., deciding

whether to amend a written document, deciding whether to purchase supplies, deciding

whether to make a hire, deciding whether to fulfill a purchase order, *ad infinitum*). Thus,

Kuo is "reasonably pertinent to the particular problem with which the Applicant was

concerned."

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (571) 272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
February 1, 2005

HEATHER R. HERNDON
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